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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT E. HAINES
and JUDITH A. GARZOLINI

Appeal 2009-009085
Application 09/981,117
Technology Center 2600

Before ALLEN R. MacDONALD, ELENI MANTIS MERCADER, and
CARL W. WHITEHEAD, JR., *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF CASE

Introduction

Appellants appeal under 35 U.S.C. § 134 from a rejection of claims 1-5, 10, 11, 13-17, and 20-23. The rejection of claim 9 is not appealed. Claims 18 and 19 have been canceled. Claims 6-8 and 12 are not rejected. We have jurisdiction under 35 U.S.C. § 6(b).

Exemplary Claim(s)

Exemplary independent claim 1 under appeal reads as follows:

1. An image forming device comprising:
 - a housing including a media path arranged to guide media;
 - a first sensor configured to obtain encoded data from the media and to output a first signal indicative of the encoded data;
 - a second sensor configured to monitor an ambient condition within an environment in which the image forming device is deployed and to output a second signal indicative of the ambient condition; and
 - imaging circuitry configured to form hard images upon the media, to receive the first signal, to receive the second signal, and to perform at least one function with respect to the formation of the hard images within the image forming device responsive to the encoded data indicated within the first signal and the second signal indicative of the ambient condition.

Rejections on Appeal

The Examiner rejected claims 1-5 and 11 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Siwinski (US 2002/0015066 A1) and Kawabata (US 5,905,925).

The Examiner rejected claim 10, which depends from claim 1, under 35 U.S.C. § 103(a) as being unpatentable over the combination of Siwinski, Kawabata, and Matthews (US 2002/0097422 A1).²

The Examiner rejected claim 21, which depends from claim 1, under 35 U.S.C. § 103(a) as being unpatentable over the combination of Siwinski, Kawabata, and Gonnella (US 6,577,825 B1).³

The Examiner rejected claims 13-15, 20, and 23 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Siwinski and Matthews.

The Examiner rejected claims 16 and 17, which depends from claim 15, under 35 U.S.C. § 103(a) as being unpatentable over the combination of Siwinski, Matthews, and Kawabata.

The Examiner rejected claim 22, which depends from claim 13, under 35 U.S.C. § 103(a) as being unpatentable over the combination of Siwinski, Matthews, and Gonnella.

Appellants' Contentions

1. In argument Section B at pages 5-8 of Appellants' pre-KSR Appeal Brief, Appellants contend that the Examiner erred in rejecting claims 1-5, 11, and 21 under 35 U.S.C. § 103(a) as being unpatentable because the Examiner has not followed the guidance of the Federal Circuit in *In re Lee*. Appellants repeat their reliance on *In re Lee* in their post-KSR Reply Brief at pages 1-4.

² In stating the rejection of claim 10, the Examiner misstates the rejection of claim 1 as being based on Siwinski alone.

³ In stating the rejection of claim 21, the again Examiner misstates the rejection of claim 1 as being based on Siwinski alone.

2. In argument Section C at pages 8-11 of Appellants' pre-KSR Appeal Brief, Appellants contend that the Examiner erred in rejecting claims 10, 13-17, 20, 22, and 23 under 35 U.S.C. § 103(a) as being unpatentable again because the Examiner has not followed the guidance of the Federal Circuit in *In re Lee*.

3. In argument Section C at page 10 of the Appeal Brief, Appellants also contend that the Examiner erred in rejecting claims 13-17, 20, 22, and 23 under 35 U.S.C. § 103(a) as being unpatentable because:

At pages 2-3 in the "Response to Arguments" portion of the Office Action, the Office states that Siwinski teaches automatically providing error messages. Appellants traverse the statement and submit Appellants have failed to uncover any identification of automatic teachings as baldly alleged by the Office.

4. In argument Section C at page 11 of the Appeal Brief, Appellants contend that the Examiner erred in rejecting claim 10 under 35 U.S.C. § 103(a) as being unpatentable because:

The Office at page 3 further alleges that it doesn't matter how many trays there are in a system, Appellants respectfully disagree. Matthews is directed towards high output system using a plurality of feeders and plural types of media, Accordingly, it is beneficial in the system of Matthews to help users with knowing which of numerous feeders and the numerous media types used thereby are likely to experience problems. To the contrary, Siwinski is directed towards a single feeder system not of the complexity of Matthews and there [is] no evidence of record that the combination proposed by the Office resolves any issues of concern to Siwinski.

5. In argument Section D at pages 11-12 of the Appeal Brief, Appellants contend that the Examiner erred in rejecting claims 13-17, 20, 22, and 23 under 35 U.S.C. § 103(a) as being unpatentable because:

The Office states on page 11 of the Action that Siwinski teaches maintenance and error messages but fails to teach that a message identifies the media. Furthermore, Appellants have failed to uncover any teachings in Siwinski that any messages are communicated responsive to encoded data retrieved from media. The Office relies upon the teachings of Matthews and states that paragraph 0022 of Matthews discloses sending an error message to a user identifying media that is causing troubles. Referring to Fig. 2, paragraph 0022, Matthews states that a user may add a remark warning other users about a particular L rand of paper that is causing jams. To the contrary, claim 13 positively defines retrieving encoded data from the media and performing at least one function comprising communicating a message identifying the media to the host device responsive to the encoded data. The inputting of information by a user fails to disclose or suggest the claimed communicating responsive to the encoded data retrieved from the media. (emphasis omitted).

6. In argument Section G at pages 14-15 of the Appeal Brief, Appellants contend that the Examiner erred in rejecting claim 23 under 35 U.S.C. § 103(a) as being unpatentable because (emphasis omitted):

Claim 23 recites communicating the message identifying the host device automatically without user input and responsive to encoded data retrieved from media. At page 12 of the Action, the Office baldly alleges that Siwinski teaches automatically displaying error and maintenance messages with reference to paragraph 0037 of Siwinski. However, referring to paragraph 0037, Siwinski discloses that control console 30 performs operations such as displaying maintenance and error messages without any recitation to the displaying being automatic or responsive to encoded data retrieved from media. Appellants have failed to uncover any teachings in Siwinski of

automatically displaying error and maintenance messages as positively claimed.

To the contrary, the teachings of Matthews, used in the 103 rejection of claim 23, states that messages inputted by a user may be displayed. Accordingly, the combined teachings of Matthews and Siwinski fail to teach the claimed automatic communication without user input and responsive to encoded data, and to the contrary disclose the user inputting the message. When the references teachings are properly considered as a whole it is clear that the references do not teach the automatic communication as defined in claim 23 but to the contrary involve explicit user intervention.

Issue on Appeal

Did the Examiner err in rejecting claims 1-5, 10, 11, 13-17, and 20-23 as being obvious because the references fail to teach or suggest the argued limitations?

ANALYSIS

We have reviewed the Examiners' rejections in light of Appellants' arguments (Appeal Brief and Reply Brief) that the Examiner has erred.

We disagree with Appellants' conclusion. We adopt as our own (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken and (2) the reasons set forth by the Examiner in the Examiner's Answer in response to Appellants' Appeal Brief. We concur with the conclusion reached by the Examiner.

As to Appellants' contention numbered as 1 above, while it was facially reasonable to rely on *In re Lee* in Appellants pre-KSR Appeal Brief, it was wholly unreasonable to do so in Appellants' post-KSR Reply Brief while at the same time ignoring the Court's KSR guidance. *KSR Intern. Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007). Following the legal standard set forth

by the Court in *KSR*, we conclude that the situation before us is most analogous to that found in *Anderson's-Black Rock, Inc.* as discussed by the Court in *KSR*:

In *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 90 S.Ct. 305, 24 L.Ed.2d 258 (1969), the Court elaborated on this approach. The subject matter of the patent before the Court was a device combining two pre-existing elements: a radiant-heat burner and a paving machine. The device, the Court concluded, did not create some new synergy: The radiant-heat burner functioned just as a burner was expected to function; and the paving machine did the same. The two in combination did no more than they would in separate, sequential operation. *Id.*, at 60-62, 90 S.Ct. 305. In those circumstances, “while the combination of old elements performed a useful function, it added nothing to the nature and quality of the radiant-heat burner already patented,” and the patent failed under § 103. *Id.*, at 62, 90 S.Ct. 305 (footnote omitted).

KSR, 550 U.S. at 416-17. We conclude that combining the two pre-existing elements (encoded data and ambient condition) without some new synergy does not require the argued teaching, suggestion, or motivation. Therefore, the Examiner did not err based on this contention set forth by Appellants. However, even if such were required, contrary to Appellants arguments (App. Br. 8), both Siwinski and Kawabata provide such in that they are directed to the same or similar materials (“textiles, and other substrates” in Siwinski at ¶ [0003] and “cloth paper” in Kawabata at col. 1, ll. 11-13).

As to Appellants’ contention numbered as 2 above, we again point out that Appellants’ reliance on *In re Lee* is misplaced. Rather, the Court’s *KSR* guidance is controlling.

As to Appellants' contention numbered as 3 above, we agree with the Examiner that Siwinski teaches automatically providing error messages. In particular, at ¶ [0037] Siwinski states (emphasis added):

A control console 30 which serves as, a separate computer connected to inkjet printer 10, is used to monitor and control inkjet printer 10 operation. Control console 30 performs operations such as file transfer and job queuing, and displaying maintenance and error messages. A computer program running on control console 30 performs the logic control processing functions of the printer, providing operating instructions to a machine control processor 32, which is a microprocessor-based controller that runs what is commonly-known in the art as "low-level" processes of inkjet printer 10.

We find that one skilled in the art would understand this to be automatically providing error messages.

As to Appellants' contention numbered as 4 above, we agree with the Examiner that Matthews teaches a printer with multiple trays. We further agree with the Examiner that it would have been obvious to provide multiple trays in other printers such as Siwinski. "[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." *KSR*, 550 U.S. at 417.

As to Appellants' contention numbered as 5 above, we disagree with Appellants' conclusion. Appellants' arguments focus on the individual differences between the limitations of claim 13 and the Siwinski and Matthews references. It is apparent, however, from the Examiner's line of reasoning in the Final Rejection, that the basis for the obviousness rejection is the combination of Siwinski and Matthews. One cannot show

nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Keller*, 642 F.2d 413, 425-26 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). The Examiner has relied on Siwinski to teach printer error messages and on Matthews to teach that error messages containing identification of the media. Contrary to Appellants' arguments, that Siwinski fails to teach any messages identifying the media is not relevant to the rejection before us. Similarly, how Matthews initially identifies the media is not relevant to the rejection before us.

As to Appellants' contention numbered as 6 above, we disagree with Appellants' conclusion for the reasons already set forth above.

CONCLUSIONS

(1) The Examiner has not erred in rejecting claims 1-5, 10, 11, 13-17, and 20-23 as being unpatentable under 35 U.S.C. § 103(a).

(2) Claims 1-5, 10, 11, 13-17, and 20-23 are not patentable.

DECISION

The Examiner's rejections of claims 1-5, 10, 11, 13-17, and 20-23 are affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(v).

AFFIRMED

KIS

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